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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/583,576

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Glen Ernst

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02/12/2009

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GLOBAL INTELLECTUAL PROPERTY
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EXAMINER

MCDOWELL, BRIAN E

ART UNIT

PAPER NUMBER

1624

MAIL DATE

DELIVERY MODE

02/12/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/583,576	Applicant(s) ERNST ET AL.	
	Examiner BRIAN MCDOWELL	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/2/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-17 is/are pending in the application.
- 4a) Of the above claim(s) 7-11 and 13-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Status of Claims

Claims 1-4 and 6-17 are pending. Claims 5 and 18-19 have been cancelled.
Claims 1-3 and 6 have been amended and claims 7-11 and 13-17 are withdrawn.

Status of Rejections

Double Patenting

Applicant's arguments of claims 1-4,6, and 12, see Remarks, filed 12/2/2008, with respect to the Non-Final Office Action mailed 9/2/2008 have been fully considered and the rejection is still maintained for the reasons of record.

35 USC §112 (1st Paragraph)

Applicant's amendment of claims 1-4,6, and 12, see Remarks, filed 12/2/2008, with respect to the Non-Final Office Action mailed 9/2/2008 has been fully considered and the rejection has been withdrawn.

35 USC § 102

Applicant's amendment of claim 1, see Remarks, filed 12/2/2008, with respect to the Non-Final Office Action mailed 9/2/2008 has been fully considered and the rejection has been withdrawn.

35 USC § 103

Applicant's amendment and arguments of claims 1-4,6, and 12 (rejection now applicable to claims 1-4 and 12) see Remarks, filed 12/2/2008, with respect to the Non-

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Final Office Action mailed 9/2/2008 have been fully considered but are not found persuasive.

As mentioned in the previous office action, Peter *et al.* disclose a compound wherein Ar¹ = furanyl, D = O, E = single bond, and G = H (see page 5, [0081]). The document also mentions that Ar¹ may be substituted with a halogen (see page 2, [0022]).

The only difference between applicant's compound and the compound described by Peter *et al.* is the lack or presence thereof an additional methylene group (-CH₂)₂ which link the nitrogen to the ring. However, the genus formula in the Peter *et al.* document teach that the bridgehead carbons may be made of 1 or 2 carbons (see page 5, [0059]). *Additionally, MPEP states that compounds which are homologs (compounds differing regularly by the successive addition of the same chemical group, e.g., by -CH₂- groups) are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties. In re Wilder, 563 F.2d 457, 195USPQ 426 (CCPA 1977).*

Therefore, the compounds in the instant application are obvious.

New Objections and Rejections

Specification

The disclosure is objected to because of the following informalities: The first paragraph in the Specification should indicate up-to-date claims of benefit to priority

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U.S. Applications. Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11. Appropriate correction is required.

Claim Rejections - 35 USC § 112 (2nd Paragraph)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recite the limitation "A compound according to Formula I, wherein Ar¹ is selected from phenyl, furanyl, thiophenyl or 1-methyl-1H-pyrrolyl". There is insufficient antecedent basis for this limitation in the claim since Formula I is seen in claim 1 wherein Ar¹ can only be furanyl or thiophenyl.

Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN MCDOWELL whose telephone number is (571)270-5755. The examiner can normally be reached on Monday-Thursday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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**/James O. Wilson/
Supervisory Patent Examiner, Art Unit 1624**